

REMARKS

In the Notice of Allowability issued on May 3, 2005, the Examiner states on page 3, paragraph C, that Applicant and Applicant's representative have failed to comply with the duty of disclosure regarding U.S. App. No. 10/638,368, issued on May 17, 2005 as USP 6,893,807, because of the "closely related inventions" contained in the instant application and the '807 patent.

Applicant and Applicant's representative state for the record that there was no intent to withhold any information that the Examiner might deem relevant from the Examiner or the USPTO. Applicant's representative further notes that the '807 patent was filed on August 12, 2003, whereas the instant application was filed on February 25, 2004 and published on November 18, 2004. As such, neither the instant application as filed nor the corresponding published application are prior art against the '807 patent.

Applicant's representative has reviewed the instant claims and those of the '807 patent and find that the claims are drawn to different subject matter; therefore there is no statutory double patenting issue regarding the '807 patent and instant application. Inasmuch as there may be any double patenting issues under the judicially created doctrine of obviousness-type double patenting, MPEP §804 states,

If the "provisional" double patenting rejections in both applications are the only rejections remaining in those applications, the examiner should then withdraw that rejection in one of the applications (e.g., the application with the earlier filing date) and permit the application to issue as a patent. The examiner should maintain the double patenting rejection in the other application as a "provisional" double patenting rejection which will be converted into a double patenting rejection when the one application issues as a patent. MPEP §804

Thus, if there was potentially an obviousness-type double patenting issue between the then-pending claims of the '807 patent and the '066 application, the '807 patent, which has the earlier filing date should have been allowed to issue and the obviousness-type double patenting rejection should be made still pending '066 application. Since the Examiner, by evidence of his own comments, is aware of the '807 patent and the subject matter claimed therein, but has not made an obviousness-type double patenting rejection, Applicant can only conclude that the Examiner has found the subject matter of the '807 patent and the '066 application to be

Application No.: 10/785,066


Docket No.: 0649-0944P

patentably distinct. As such, Applicant and Applicant's representative believe that no additional action needs to be taken regarding this matter or in furtherance of the duty of disclosure regarding the '807 patent.

If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

Dated: August 2, 2005

Respectfully submitted,

By 
Mary Anne Armstrong, Ph.D.
Registration No.: 40,069
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Rd
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant